

**REMARKS**

In response to the Office Action of June 10, 2009, Applicant submits the following remarks.

The Office Action notes that claims 1-9, 11-30, and 32-41 are pending in the present application. In this response, claims 1, 13, and 30 are amended, thereby leaving claims 2-9, 11, 12, 14-20, 29, and 32-41 unchanged and claims 21-28 withdrawn. Therefore, claims 1-9, 11-20, 29, 30, and 32-41 are currently under consideration in the present application.

***Claim Rejections - 35 U.S.C. §101***

Claims 1-20, 30, and 32-41 stand rejected under 35 U.S.C. §101 as being directed to non-statutory subject matter. More particularly, the Examiner states that "claims 1-20, 30, and 32-[41] identify neither the apparatus performing the recited steps nor any transformation of underlying materials." The Examiner also states, in the "Response to Arguments" section of the Office Action, "Applicant has amended claim 1 to recite 'a server and a network', this amendment is nominal recitation of pre and post solution activity. It is still not apparent what apparatus is performing the determining and identifying functions."

Initially, Applicant respectfully traverses the Examiner's reasoning for this rejection. The Examiner appears to be contending that *every step* of an independent process claim *requires recitation of the apparatus performing the step* in order to tie each step to a statutory class. Applicant submits that this contention is an incorrect interpretation of the statutory subject matter requirement, which the Examiner herself presents. Specifically, the Examiner states that "[t]o qualify as statutory subject matter, a claimed process should either: (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials)" (emphasis added). As is clear from the language used, nowhere in this

requirement does it state that *all* steps of a process must be tied to another statutory class or transform underlying subject matter. Rather, the requirement merely requires that the "claimed process...be tied to another statutory class (such as a particular apparatus)."

The Federal Circuit also addressed this issue in Bilski and stated,

“[T]he [Supreme] Court has made clear that it is inappropriate to determine the patent-eligibility of a claim as a whole based on whether selected limitations constitute patent-eligible subject matter. (citations omitted). After all, even though a fundamental principle itself is not patent-eligible, processes incorporating a fundamental principle may be patent-eligible. Thus, it is irrelevant that any individual step or limitation of such processes by itself would be unpatentable under § 101.” In re Bilski, 545 F.3d 943, 958 (Fed. Cir. 2008), cert. granted, 129 S. Ct. 2735 (June 1, 2009).

The Federal Circuit applied this same reasoning in Prometheus, citing the above language from Bilski, and held that the presence of recited non-statutory mental steps in a claim does not make *the claim as a whole* non-statutory subject matter if there are other recited steps that either tie the other recited steps to another statutory class or transform the underlying subject matter. Prometheus Laboratories v. Mayo Collaborative Services, No. 2008-1403 (Fed. Cir. September 16, 2009). In Prometheus, the Federal Circuit held that the presence of various “wherein” clauses in the method claims at issue that recited non-statutory mental steps did not make the claims themselves directed to non-statutory subject matter. Rather, since the claims also contained other recited steps that did transform underlying subject matter, *the claim as a whole* was directed to statutory subject matter under the machine or transformation test.

This same reasoning is also consistent with the USPTO’s “New Interim Patent Subject Matter Eligibility Examination Instructions” memorandum dated August 24, 2009 (“the USPTO Guidelines”). According to the USPTO guidelines, to determine if a claim is directed to statutory subject matter: (1) the meaning of the claim *as a whole* must be determined; (2) it must be determined if *the claim as a whole* falls within one of the four categories of invention; (3) it

must be determined if *the claim as a whole* is directed to a particular practical application of a judicial exception. (see Section III, pages 6-8). It is also consistent with the process example given on slide 15 of the presentation attached to the USPTO Guidelines. The process example given on slide 15 claims a method comprising three steps. The first two steps merely recite sorting results and ranking results without tying the steps to another statutory class or transforming any underlying subject matter. However, the third step recites comparing ranked results “using a microprocessor”. The conclusion in the USPTO Guidelines is that this claim as a whole is directed to patentable subject matter because the third recited step does recite a particular machine (a computer or microprocessor must be particularly programmed to perform the recited step and therefore is a particular machine) and the recited step was a meaningful limitation that was more than insignificant extra-solution activity.

Based on the above, Applicant respectfully submits that claims 1-20, 30, and 32-41 as presented in the prior communication filed March 23, 2009, do recite a particular apparatus that imposes a meaningful limit and, therefore, are directed to statutory subject matter.

However, in the interest of furthering prosecution of the present application, Applicant has amended independent claims 1, 13, and 30 above to include additional elements as requested by the Examiner. Therefore, withdrawal of the this rejection is respectfully requested.

#### ***Claim Rejections – 35 USC §103(a)***

Claims 1-6, 9, 11-16, 19, 20, 29, 30, and 32-41 stand rejected under 35 USC §103(a) as being unpatentable over U.S. Published Patent Application No. 2004/0078252 ("Daughtrey") in view of U.S. Published Patent Application No. 2001/0034625 ("Kwoh"). Also, claims 7, 8, 17, and 18 stand rejected under 35 USC §103(a) as being unpatentable over Daughtrey in view of Kwoh and further in view of U.S. Patent No. 6,304,850 ("Keller").

In proceedings before the Patent and Trademark Office, the Examiner bears the burden of presenting a *prima facie* case of obviousness based upon the prior art. In re Fritch, 972 F.2d 1260, 1265, 23 U.S.P.Q.2d 1780, 1783 (Fed. Cir. 1992); In re Fine, 837 F.2d 1071, 1074, 5 U.S.P.Q.2d 1596, 1598 (Fed. Cir. 1988). To establish a *prima facie* case of obviousness, the prior art reference (or references when combined) must teach or suggest all of the claim limitations. In re Royka, 490 F.2d 981, 985, 180 U.S.P.Q. 580, 583 (CCPA 1974); MPEP §§ 706.02(j), 2143.03.

Claims 1-9, 11, 12, and 34

In the following remarks, Applicant will identify at least six different elements of independent claim 1 that are not taught or suggested by Daughtrey or Kwoh, either alone or in combination, thereby establishing that a *prima facie* case of obviousness has not been established in connection with independent claim 1 and its dependent claims.

First, Daughtrey does not teach or suggest, *inter alia*, "simultaneously providing a plurality of flexible date search options to a user", as recited in independent claim 1. As can be seen in Fig. 2 and paragraph [0024] of Daughtrey, the system in Daughtrey only provides a single flexible date search option to the user (pane 41e), which allows a user to search only based on an earliest departure date and a length of stay. There is nothing in Daughtrey suggesting the provision of other flexible date search options. In the Office Action, the Examiner relies on "Fig. 2 and para. 31" of Daughtrey as the basis for this rejection (see paragraph 6, page 5 of the Office Action). After reviewing Fig. 2 and paragraph [0031], there is no mention of simultaneously providing a plurality of flexible date search options as recited in independent claim 1. In fact, a telephone interview was conducted on September 23, 2008, between Examiner Hayes, Gregory M. Smith, and Paul M. McGinley to discuss this limitation of independent claim 1. Shortly after

this telephone interview, Examiner Hayes left a voicemail for Paul M. McGinley on October 8, 2008, indicating that Examiner Hayes acknowledges that Daughtrey does not teach or suggest "simultaneously providing a plurality of flexible date search options to a user" as recited in independent claim 1. Accordingly, Daughtrey does not teach or suggest this limitation of independent claim 1. The Examiner does not attempt to use Kwoh to cure this deficiency. Applicant believes the Examiner does not make such a contention because Kwoh does not cure this deficiency of Daughtrey. Accordingly, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest this limitation of independent claim 1.

Second, Daughtrey does not teach or suggest, *inter alia*, a "user entered trip date interval comprising a user entered departure date and a user entered return date", as recited in independent claim 1 (emphasis added by Applicant). After a detailed review of Daughtrey, Daughtrey only allows a user to specify an earliest departure date and a length of stay (see Fig. 2 of Daughtrey). Daughtrey does not allow a user to specify a latest return date (see Fig. 2 of Daughtrey). This deficiency of Daughtrey has been acknowledged several times by the Examiner and most recently in paragraph 6, page 5 of the Office Action. Accordingly, Daughtrey does not teach or suggest this limitation of independent claim 1.

The Examiner attempts to use Kwoh to cure this deficiency of Daughtrey. More particularly, the Examiner states that "Kwoh teaches a user entering a return date for the purposes of searching for a flight (see para.48)." The Examiner's reasoning for combining the teachings of Kwoh with Daughtrey is as follows: "One of ordinary skill in the art...would have found it obvious and recognized that a user entering a return date would have yielded predictable results. i.e. providing search parameters for a travel search as described in Daughtrey para. 25" (see paragraph 6, page 5 of the Office Action). With specific reference to paragraph 25 of

Daughtrey, it discloses non-preferred and inferior searching methods, which are ultimately used to establish the benefits of the Daughtrey invention over these inferior searching methods. More particularly, paragraph 25 recites that the search engine would be overburdened if a user entered an earliest possible departure date, latest possible departure date, earliest possible return date, and latest possible return date due to the large number of combinations resulting from such input data. Accordingly, paragraph 25 of Daughtrey teaches away from entering return dates. “A prior art reference must be considered in its entirety, i.e., as a whole, including portions that would lead away from the claimed invention.” W.L Gore & Associates, Inc. v. Garlock, Inc., 721 F.2d 1540, 220 U.S.P.Q. 303 (Fed. Cir. 1983), cert. denied, 469 U.S. 851 (1984); MPEP § 2141.02. It is improper to combine references where the references teach away from their combination. In re Grasselli, 713 F.2d 731, 743, 218 U.S.P.Q. 769, 779 (Fed. Cir. 1983); MPEP § 2145(X)(D)(2). Further, if the proposed modification would render the prior art invention being modified unsatisfactory for its intended purpose, then there is no suggestion or motivation to make the proposed modification. In re Gordon, 733 F.2d at 902, 221 U.S.P.Q. at 1127. Daughtrey explicitly teaches in paragraph 25 that it is undesirable to include a user entered return date because the results would overburden the search engine. Thus, the Examiner's attempt to modify Daughtrey to include the user entered return date of Kwoh would render the Daughtrey invention unsatisfactory for its intended purpose. Accordingly, Applicant respectfully submits that the Examiner's proposed combination of Kwoh with Daughtrey is improper. As a result, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest this limitation of independent claim 1.

Third, Daughtrey does not teach or suggest, *inter alia*, "a user entered trip date interval and a user entered trip length" (emphasis added by Applicant), as recited in independent claim 1.

The Examiner's sole basis for rejecting this limitation of independent claim 1 is the reliance on "Fig. 2" of Daughtrey (see paragraph 6 of the Office Action). With reference to Fig. 2, Daughtrey only discloses a user entered departure date (see reference no. 43) and a user entered trip length (see reference no. 44). As indicated in the previous paragraph, a user entered trip date interval comprises "a user entered departure date and a user entered return date" (emphasis added by Applicant). Since the Examiner acknowledges that Daughtrey does not teach or suggest a "user entered return date", Daughtrey cannot teach or suggest a user entered trip date interval. Accordingly, Daughtrey does not teach or suggest this limitation of independent claim 1. The Examiner attempts to rely on Kwoh to cure this deficiency of Daughtrey. For the sake of brevity, reference is made to the previous paragraph where Applicant present remarks to rebut the Examiner's contended combination of Kwoh and Daughtrey and the contended modification of Daughtrey. Accordingly, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest this limitation of independent claim 1.

Fourth, Daughtrey does not teach or suggest, *inter alia*, "wherein the user entered trip length is less than a period of time between the user entered departure date and the user entered return date" (emphasis added by Applicant), as recited in independent claim 1. As acknowledged by the Examiner numerous times throughout prosecution of the present application and most recently in paragraph 6, page 5 of the Office Action, Daughtrey does not teach or suggest a user entering all three of: a departure date, a return date, and a trip length. Also, in section 3 of the Office Action dated June 25, 2008, the Examiner refers to Fig. 2 of Daughtrey and indicates that the return date of "October 17" is derived from the departure date of "October 10" plus the trip interval of "1 week". In other words, the departure date plus the trip length equals the return date. This simple mathematical equation used by the Examiner to arrive

at a return date clearly establishes that the trip length disclosed by Daughtrey is equal to the period of time between the departure date and the return date, not less than the time period between the departure date and the return date as recited in independent claim 1. Accordingly, Daughtrey does not teach or suggest this limitation of independent claim 1.

The Examiner acknowledges that Daughtrey does not teach a trip length less than a period of time between a departure date and the return date (see paragraph 6, page 5 of the Office Action). The Examiner does not provide an additional reference to cure this deficiency of Daughtrey. Accordingly, the Examiner has failed to show a prior art reference or combination of prior art references that teach this limitation of independent claim 1.

Instead, the Examiner attempts to rely on *In re Aller*, 220 F.2d 454, 456, 105 USPQ 233, 235 (CCPA 1955) to cure this deficiency of Daughtrey. *In re Aller* relates to temperature ranges, element ranges of compositions, and laboratory experimentation to arrive at the desired temperature and composition ranges. The Examiner relies on *In re Aller* to contend that "it is not inventive to discover the optimum or workable ranges where the general conditions of a claim are disclosed in the prior art." Applicant respectfully submits that the facts and circumstances of *In re Aller* are non-analogous with independent claim 1 of the present application. More particularly, the present application and independent claim 1 generally relate to a method of identifying a plurality of alternate travel itineraries achieved by the use of electronics and software, and receiving a user entered trip length that less than a user entered trip date interval has nothing to do with optimizing ranges. There are no ranges to be optimized. Rather, independent claim 1 recites "the user entered trip length is less than a period of time between the user entered departure date and the user entered return date" (emphasis added by Applicant). Furthermore, the basis of *In re Aller* requires that "the general conditions of the claim [be]



disclosed in the prior art." Applicant establishes both in the previous paragraphs and the following paragraphs of this response that Daughtrey and Kwoh lack numerous elements of independent claim 1, thereby establishing that "the general conditions" of independent claim 1 are not present in Daughtrey and Kwoh. Accordingly, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest this limitation of independent claim 1.

Fifth, Daughtrey does not teach or suggest, *inter alia*, "receiving a search option selection from a user", as recited in independent claim 1. As indicated above, Daughtrey does not teach or suggest "simultaneously providing a plurality of flexible date search options." Since Daughtrey does not teach or suggest simultaneously providing a plurality of flexible date search options, the user has no options from which to select. In other words, Daughtrey only discloses a single flexible date search option and, therefore, the user is forced to use the single flexible date search option. Thus, the user does not perform any "selecting" with Daughtrey, which precludes Daughtrey from teaching or suggesting "receiving a search option selection from the user" (emphasis added by Applicant). Accordingly, Daughtrey does not teach or suggest this limitation of independent claim 1. The Examiner does not attempt to use Kwoh to cure this deficiency. Applicant believes the Examiner does not make such a contention because Kwoh does not cure this deficiency of Daughtrey. Accordingly, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest this limitation of independent claim 1.

Sixth, Daughtrey does not teach or suggest, *inter alia*, "requesting travel date information from the user based on the search option selection" (emphasis added by Applicant), as recited in independent claim 1. As indicated in the previous paragraph, the user cannot select a flexible date search option because only one flexible date search option exists and the user is forced to use the single flexible date search option. Since the user does not "select" a flexible date search

option, Daughtrey cannot disclose a subsequent step that is based on or relies on a selected flexible date search option. With respect to the specific limitation of independent claim 1, Daughtrey cannot teach or suggest "requesting travel date information from the user based on the search option" (emphasis added by Applicant). Accordingly, Daughtrey does not teach or suggest this limitation of independent claim 1. The Examiner does not attempt to use Kwoh to cure this deficiency. Applicant believes the Examiner does not make such a contention because Kwoh does not cure this deficiency of Daughtrey. Accordingly, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest this limitation of independent claim 1.

For at least these reasons, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest all the subject matter of independent claim 1 and, therefore, the Examiner fails to establish a *prima facie* case of obviousness of independent claim 1. Accordingly, independent claim 1 is allowable. Claims 2-9, 11, 12, and 34 depend from independent claim 1 and are allowable for at least the same reasons as independent claim 1.

#### Claims 13-20 and 35-37

In the following remarks, Applicant will identify at least five different elements of independent claim 13 that are not taught or suggested by Daughtrey and Kwoh, either alone or in combination, thereby establishing that a *prima facie* case of obviousness has not been established in connection with independent claim 13 and its dependent claims.

Regarding independent claim 13, Daughtrey and Kwoh do not teach or suggest, *inter alia*, "simultaneously providing a plurality of flexible date search options to a user", "a user entered trip date interval and a user entered trip length", "wherein the user entered trip length is less than a period of time between the user entered departure date and the user entered return date", "receiving a search option selection from a user", and "requesting travel date information

from the user based on the search option selection" (emphasis added by Applicant). For the sake of brevity, the remarks presented above to distinguish independent claim 1 from Daughtrey and Kwoh apply *mutatis mutandis* to distinguish independent claim 13 from Daughtrey and Kwoh, and will not be repeated herein.

For at least these reasons, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest all the subject matter of independent claim 13 and, therefore, the Examiner fails to establish a *prima facie* case of obviousness of independent claim 13. Accordingly, independent claim 13 is allowable. Claims 14-20 and 35-37 depend from independent claim 13 and are allowable for at least the same reasons as independent claim 13.

#### Claims 29 and 38-40

In the following remarks, Applicant will identify at least five different elements of independent claim 29 that are not taught or suggested by Daughtrey and Kwoh, either alone or in combination, thereby establishing that a *prima facie* case of obviousness has not been established in connection with independent claim 29 and its dependent claims.

Regarding independent claim 29, Daughtrey and Kwoh do not teach or suggest, *inter alia*, "means comprising simultaneously providing a plurality of flexible date search options to a user", "a user entered trip date interval and a user entered trip length", "wherein the user entered trip length is less than a period of time between the user entered departure date and the user entered return date", "means for receiving a search option selection from a user", and "the means comprising requesting travel date information from the user based on the flexible date search option selection" (emphasis added by Applicant). For the sake of brevity, the remarks presented above to distinguish independent claim 1 from Daughtrey and Kwoh apply *mutatis mutandis* to distinguish independent claim 29 from Daughtrey and Kwoh, and will not be repeated herein.

For at least these reasons, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest all the subject matter of independent claim 29 and, therefore, the Examiner fails to establish a *prima facie* case of obviousness of independent claim 29. Accordingly, independent claim 29 is allowable. Claims 38-40 depend from independent claim 29 and are allowable for at least the same reasons as independent claim 29.

Claims 30, 32, 33, and 41

Regarding independent claim 30, Daughtrey does not teach or suggest, *inter alia*, "receiving travel date information from the user...the travel date information comprising a trip date range, the trip date range comprising a user specified earliest departure date and a user specified latest return date, and a trip length" (emphasis added by Applicant). Rather, Daughtrey only allows a user to specify an earliest departure date and a length of stay. Daughtrey does not allow a user to specify a latest return date (see Fig. 2 of Daughtrey). This deficiency of Daughtrey has been acknowledged several times by the Examiner and most recently in paragraph 6, page 5 of the Office Action. Accordingly, Daughtrey does not teach or suggest this limitation of independent claim 30.

The Examiner attempts to use Kwoh to cure this deficiency of Daughtrey. For the sake of brevity, reference is made to the remarks presented above to establish that a combination of Daughtrey and Kwoh is improper and the proposed modification of Daughtrey to include a user entered return date is improper. Accordingly, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest this limitation of independent claim 30.

Additionally, Daughtrey does not teach or suggest, *inter alia*, wherein the trip length is less than the trip date range, which is comprised of a user specified earliest departure date and a user specified latest return date. For the sake of brevity, reference is made to the remarks

presented above in connection with independent claims 1, 13, and 29 to establish Daughtrey and Kwoh's failure to teach or suggest this limitation.

For at least these reasons, Daughtrey and Kwoh, either alone or in combination, do not teach or suggest all the subject matter of independent claim 30 and, therefore, the Examiner fails to establish a *prima facie* case of obviousness. Accordingly, independent claim 30 is allowable. Claims 32, 33, and 41 depend from independent claim 30 and are allowable for at least the same reasons.

### ***Conclusion***

In view of the aforesaid, Applicant respectfully submits that claims 1-9, 11-30, and 32-41 are in condition for allowance and a Notice of Allowance for these claims is respectfully requested.

Respectfully submitted,

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